

REMARKS

Applicants have amended claim 13. Thus, claims 1, 2, 4 - 14 and 16 - 18 are presented for examination. Applicants respectfully request reconsideration and allowance of the pending claims in view of the foregoing amendments and the following remarks.

Response to rejections under Section 112 First Paragraph:

Claims 1 - 2, 4 - 14 and 16 - 18 stand rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement for containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors had possession of the claimed invention at the time the application was filed. In Claims 1, 13 and 14 the Examiner has indicated that the claim limitation “without melting and homogenizing a region of the substrate located laterally adjacent the melted an homogenized substrate region” is new matter.

Applicants respectfully contend that the specification and Figures 1a-d provide sufficient support for the above identified claim limitation. Specifically, the specification discloses homogenizing near-surface coating particles (Spec. p. 2, lines 16-20 and p. 5 lines 1-2) and Figure 1c shows the combined substrate (1), layer (13) and irradiation device (19) during the irradiation process step. The representation of the layer surface (15) shows an irregular surface profile and a non-irregular substrate surface (3) profile. Figure 1d shows the combined substrate (1) and layer (13) after the irradiation process step where the layer surface is represented as a non-irregular surface which graphically represents the disclosed “homogenization in the near-surface region” (Spec. p.5, lines 1-2). Importantly, the substrate is represented identically in all of figures 1a-d thereby indicating that “melting and homogenizing a region of the substrate located laterally adjacent the melted an homogenized substrate region” has not occurred.

Applicants respectfully submit that the Examiner has a very difficult burden to make and maintain a 35 U.S.C. § 112, para. 1 rejection. MPEP 2163 provides that “there is a strong presumption that an adequate written description of the claimed invention is present in the specification as filed,” citing Wertheim, 541 F.2d at 262, 191 USPQ at 96. MPEP 2161.01(III) further provides the Examiner “must establish on the record a reasonable basis for questioning the adequacy of the disclosure to enable a person of ordinary skill in the art to make and use the

claimed invention without resorting to undue experimentation,” citing in re Brown, 477 F.2d 946, 177 USPQ 691 (CCPA 1973); In re Ghiron, 442 F.2d 985, 169 USPQ 723 (CCPA 1971).

Moreover, MPEP 2163.04 requires that:

In rejecting a claim, the examiner must set forth express findings of fact which support the lack of written description conclusion (see MPEP § 2163 for examination guidelines pertaining to the written description requirement). These findings should:

- (A) Identify the claim limitation at issue; and
- (B) Establish a *prima facie* case by providing reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the invention as claimed in view of the disclosure of the application as filed.... When appropriate, suggest amendments to the claims which can be supported by the application’s written description, being mindful of the prohibition against the addition of new matter in the claims or description.

Since the Examiner has failed to provide reasons why a person skilled in the art at the time the application was filed would not have recognized that the inventor was in possession of the above identified inventive concepts and also has not shown why such skilled artisan would need to resort to undue experimentation to make and use the claimed invention, the Examiner has failed to meet the requirements of MPEP 2163.04. Withdrawal of the Section 112 first paragraph rejections are respectfully requested.

Response to rejections under Section 112 Second Paragraph:

Claim 13 stands rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicants regard as their invention. Applicants have amended claim 13 to overcome the examiners rejection. Withdrawal of the Section 112 second paragraph rejections is respectfully requested.

In light of the applicants amendment and remarks, the applicants respectfully submit that the claims are in condition for allowance.

Response to Notice of Allowable Subject Matter:


The Examiner has properly determined that the limitations of irradiating a near-surface region of the coating layer to improve adhesion of the coating layer to the substrate, and to ensure homogenization of the coating layer without homogenizing a region of the substrate located laterally adjacent the homogenized region patentably distinguish the claims over the prior art of record. Therefore, Applicants respectfully request allowance of Claims 1, 2, 4 - 14 and 16 - 18.

Conclusion

For the foregoing reasons, it is respectfully submitted that the rejections set forth in the instant Office Action are inapplicable to the present claims. Please grant any extensions of time required to enter this paper. The commissioner is hereby authorized to charge any appropriate fees due in connection with this paper, or credit any overpayments to Deposit Account No. 19-2179.

Respectfully submitted,

Dated: 10/9/07

By: 
John P. Musone
Registration No. 44,961
(407) 736-6449

Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, New Jersey 08830